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EXAMINER

TUCKER, PHILIP C

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,273

Applicant(s)

QUINTERO, LIRIO

Examiner

Philip C Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/11/03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 329-391 and 413-602 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 576-602 is/are allowed.
- 6) ☒ Claim(s) 413-435, 440-444, 446-471, 474, 476-501, 508-544 and 549-575 is/are rejected.
- 7) ☒ Claim(s) 436-439, 445, 472, 473, 475, 502-507 and 545-548 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 492, 493, 570, 572 and 575 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 492 fails to teach what is reduced.

There is no antecedent basis for "said reduced surface tension" in claim 493.

There is no antecedent basis for "said" concentration in claims 570 and 572.

Dependent claim falls herewith.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 508, 509 and 512 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanco et al (5783525).

Blanco teaches an oil in water well servicing fluid which may be used for drilling, having a density within the scope of the present invention, which comprises a starch, xanthan and surfactants within the scope of the present invention (see example 6 and

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claims). The surfactant can be present in levels of from 5,000ppm to 20,000ppm. Such would inherently possess viscosity and surface tension within the scope of the present invention.

3. Claims 413-415, 422, 425, 429,430, 432-435, 440, 441, 446-471, 474, 476, 481, 482, 484, 487-500, 508-524, 531, 534, 540-544, 549-551, 555, 556, 560-562, 566-575 are rejected under 35 U.S.C. 102(b) as being anticipated by House (5977030).

House teaches a water in oil fluid which is used as a drilling fluid which comprises an oligosaccharide surfactant and a xanthan polymer (see the examples). The xanthan used would have molecular weights within the scope of the present invention (see column 4, lines 24-34). Other polymers, such as starch derivatives may be used in the drilling fluid (see column 4, lines 56-65). Fluids such as olefins and polyalphaolefins may be used as the internal phase, up to a level of about 30% (see column 3, lines 20-26 and example 1). Such would inherently possess fluid loss and surface tension within the scope of the present invention.

4. Claims 413-435, 440-444, 446-471, 476-501, 508-544 and 549-575 are rejected under 35 U.S.C. 102(b) as being anticipated by Peignier (4894335).

Peignier teaches an oil in water emulsion (see abstract and claims) which comprises a biopolymer such as xanthan having a weight within the scope of the present invention (column 2, lines 34-40), surfactants, such as sulfates, within the scope of the present invention (column 3, lines 22-30), and an oil phase within the scope of the

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invention (column 2, line 62 – column 3, line 5). Such would inherently have fluid loss and reduced surface tension properties within the scope of the present invention.

5. Claims 436-439, 445, 472, 473, 475, 502-507, 545-548 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 329-391 and 576-602 are allowable over the art of record.

7. Applicants arguments and amendments have been considered but are not deemed fully persuasive. Applicants amendment to claims having 20% or less of emulsifiable material distinguishes such claims over Blanco. Contrary to applicants assertion, Blanco teaches that the surfactant may be used at levels of from 5,000 to 20,000 ppm. Such is clearly within the scope of applicants claimed range. Case law has held that all embodiments, even those which are not preferred must be considered (In re Lamberti 192 USPQ 278). The concentration range of claim 508 is thus not distinguishing over Blanco. Contrary to applicants assertion, along with the combination of surfactant and polymer, House clearly teaches that low shear rate viscosity (LSRV) improvement is one of the features of the fluid disclosed therein (column 1, lines 61-65). Applicant has not given any reason why the combination of surfactant and polymer, in view of the LSRV teaching of House would differ from the present invention.


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A new rejection is presented in view of Peignier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Philip C Tucker  
Primary Examiner  
Art Unit 1712

PCT-2977